EXHIBIT J

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

HOLOGIC, INC., et al., :

Plaintiffs, : No. 1:15-1031-SLR

v. :

MINERVA SURGICAL, INC., :

Defendant. :

Thursday, January 5, 2016
3:00 p.m.

Discovery Dispute Hearing
Courtroom of Judge Sherry R. Fallon

844 King Street
Wilmington, Delaware

BEFORE: THE HONORABLE Sherry R. Fallon,
United States District Court Magistrate

APPEARANCES:

YOUNG, CONAWAY, STARGATT & TAYLOR LLP
BY: KAREN PASCALE, ESQ.

-and-

ARNOLD PORTER KAYE SCHOLER LLP
BY: MARC COHN, ESQ.

On behalf of Plaintiffs

APPEARANCES CONTINUED:

ROSS ARONSTAM & MORITZ LLP
BY: BENJAMIN SCHLADWEILER, ESQ.

-and-

WILSON SONSINI GOODRICH & ROSATI
BY: OLIVIA KIM, ESQ.

On behalf of Defendant

THE COURT: Hello, everyone. Please be seated. I just need a moment. I need to access the docket.

All right. Let's start with the introductions for Hologic, et al.

MS. PASCALE: Good afternoon, Your Honor. Karen Pascale from Young Conaway for Hologic and I would like to introduce Marc Cohn from Arnold Porter Kaye Scholer. And also in the courtroom today are two Hologic representatives Anne Liddy and Robert Smith.

THE COURT: Thank you, and good afternoon. And for the Defendants?

MR. SCHLADWEILER: Good afternoon, Your Honor. Ben Schladweiler from Ross, Aronstam & Moritz on behalf of Minerva. I'm joined today by Olivia Kim from Wilson Sonsini.

MS. KIM: Good afternoon.

THE COURT: Good afternoon.

MR. SCHLADWEILER: And Dom Filloux from Minerva.

THE COURT: All right. I have read the submissions. I believe the best order of the proceeding is to take each item

separately, hear argument and opposition and then go from there, so let me get out my papers.

So this is a Motion to Compel Answers to Requests for Production and Interrogatories. We'll start with the first item Requests For Production, Nos. 13 and 22.

MR. COHN: Thank you, Your Honor. Mark Cohn for Hologic. Before we jump in, I want to just preamble this briefly, Your Honor, by saying we may have more disputes down the road. I believe the scheduling order has a deadline of February for completion of documents and we learned in the meet-and-confer process by late November that it was unclear to us whether Minerva had even started collecting documents for the production and the rest of the case.

Obviously, both parties have produced documents and responses before the preliminary injunction around January of this year. In the summer we had served substantial additional requests for discovery going into the rest of the case not related to the preliminary injunction and then asked to have the prior requests updated. Since then we only received

about 500 documents from Minerva.

We expect that there may be a large document dump on us at the very last day of the period. When we have a chance to review that, we may have further disputes on that. Your Honor, we have been trying to roll Hologic's production out. I think we are not fully complete but substantially complete by this point.

THE COURT: Very well. The scheduling order, the production of paper or electronic documents by each party shall be completed before February 1. All right. I'm not going to do anything affirmatively in response to that. I will allow the normal course of proceedings to take place and the parties can reach out to me if you need to put another item on the calendar.

Typically, if you envision that there will be a number of disputes, and particularly when each side has a number of disputes, I like those outlined so that I can assess just how much time to set aside and whether or not that lends itself to additional

pages of briefing. So just keep that in mind if you're going to reach out to chambers to put another date on the calendar.

MR. COHN: Sure, we will do that. Thank you, Your Honor. So the first dispute that we raised in our letter brief relates to Requests For Production Nos. 13 and 22, and these are directed quite simply, Your Honor, documents relating to Hologic's NovaSure system and there were three disputes, but I think there has been some agreement on the third aspect.

These relate to searches in electronic information for the word NovaSure and for the phrase NS --

THE COURT: The space before and after --

MR. COHN: Yes, the space before and after. I think that Minerva has agreed to do the search for the space NS space term and also to do the search for the word NovaSure but we have a dispute as to who and when. So the first issue is who. Hologic has identified three engineer custodians that they requested Minerva to do the search on. I can name them.

Their names are listed in the brief.

THE COURT: They're listed just for the record as I believe Ms. Estela Hilario, Mr. Tejas Mazmudar and Mr. Akos Toth; is that correct?

MR. COHN: That sounds correct to me, Your Honor.

THE COURT: It says that Minerva did not identify these custodians in their initial disclosures of 10 custodians. Elaborate for me how these disclosures came about, how you became aware of these custodians and their significance in terms of the accused product.

MR. COHN: Sure. So we understand that these are three of the lead engineers who worked under Mr. Filloux who was the head of R&D in terms of developing the product. And as a senior R&D engineer, that's Mr. Mazmudar. Mr. Toth is a principal engineer and Ms. Hilario is a named inventor on two of the four patents-in-suit. As Your Honor is well aware, these patents originated at a company called Novasep and they were then purchased by Cytyc and Hologic, and some of those people are now

working at Minerva.

So we think that these three people have information that is clearly relevant or could be relevant. We don't know because we haven't seen it in terms of the development of the Minerva product. Now, the objection that we've heard from Minerva is that these are going to be cumulative of the records kept by Mr. Filloux who is their boss.

But to the extent that any of these three were talking among themselves and not communicating with Mr. Filloux and if they said anything about the NovaSure, either let's do it like the NovaSure or let's not do it like the NovaSure or anything like this, assessing the benefits, the pros and the cons of any NovaSure feature in the context of developing the Minerva product, we think that would be highly relevant.

The notion that they're cumulative of Mr. Filloux's papers I think is not -- we just don't know that, Your Honor, until we search it because I assume that these three individuals have communications that don't

involve Mr. Filloux. Obviously, to the extent they do, we have those but we would like the searches done to make sure we have a complete record of discussions about the NovaSure in the context of the development of the Minerva product.

THE COURT: Have you gone through the production made from the search of the custodian Mr. Filloux?

MR. COHN: We haven't received that, Your Honor.

THE COURT: Okay.

MR. COHN: Correct me if I'm wrong.

MS. KIM: Your Honor, we did produce production for Mr. Filloux in the preliminary injunction phase and we will be supplementing the production by February 1st, so some of the documents have been produced.

MR. COHN: So I guess the answer, Your Honor, is we haven't received all of them. We don't know how complete the production is in that regard.

THE COURT: I see.

MR. COHN: The second issue, Your Honor, relates to the date. I think Minerva has asserted a cut-off of February 1, 2015 which precedes their FDA approval by a few months, but obviously because we are looking for development of the Minerva product and any discussion of the NovaSure in the course of that development, which is a very important part of this case which involves willfulness and copying allegations, we think that any discussions of the NovaSure and the NS tag prior to the February 1, 2015 date are going to be at least critical for showing copying and willfulness allegations.

In other words, if they're talking about NovaSure in the context of their product development, that's something that is relevant or would lead to the admissibility of relevant evidence, and also the increased burden of having to search in the computer for more documents, there may be an increased review in terms of getting it out the door, but it's just a different search on the computer.

THE COURT: So how much earlier than February 1, 2015?

MR. COHN: So the company, I believe, was founded in '08, Your Honor. I'm not sure we would feel that there is a date by which we can say that we would be comfortable saying that there would be an appropriate cut-off. This company Minerva was started and immediately began developing their product to compete against the NovaSure, and I would say from day one, Your Honor, those discussions would be critical.

THE COURT: All right. Anything further before I hear from Minerva in opposition?

MR. COHN: Let me just check my notes, please. That's all I have. Thank you, Your Honor.

THE COURT: Ms. Kim?

MS. KIM: Thank you, Your Honor. For the first issue the who, we identified 10 top custodians in accordance with the ESI order which requires us to identify 10 custodians for the purpose of ESI and out of those 10 there are three key custodians that go to research and

development and design of the products, and in particular, we have Mr. Filloux who led the research and development in operation of Minerva and the Minerva accused product.

We also have Mr. Eugene Skalnyi who is the Vice-president of Medical Affairs and we also have Mr. Csaba Truckai who is the founder of Minerva. And just to be clear, for these three custodians we did not input any time limitations. We have collected all of their emails and documents in researching NovaSure, and indeed we did that in the preliminary phase as well and we will be supplementing further documents and emails in that regard.

With regard to three additional custodians that they're asking for, these are engineers that worked under Filloux and there's no indication that there will be any unique information that they possess that would be otherwise not possessed by Mr. Filloux. So it will be a duplicate effort and Minerva is a small company, and adding three more custodians in addition to the 10 custodians that we're already collecting will be very burdensome for a

company like Minerva.

THE COURT: How would it be burdensome? Describe for me the burden that would be created if the Court or hypothetically the Court would order for these custodians to be searched.

MS. KIM: Of course. We would have to collect all of their emails of the three custodians and we're not putting any time limitations on those emails. Then we would have to search for the NovaSure term and the NS term that we agreed to search for other custodians. And we would have to then review those documents for any privilege and relevance, and that is -- it is more than electronically searching documents and we do have to review those documents for privilege and also for relevance.

With regard to the second issue, the time limitation for February 1, 2015, that only goes to custodians that relate to sales and marketing of Minerva products. We're not having any time limitation for those who are involved in research, development and design of the accused products.

The Minerva product was approved by the FDA in July of 2015 and Minerva started selling the product in August of 2015. There was no reason to search for any document relating to marketing and sales before February 1, 2015. And it appears that Hologic is requesting that we collect all emails and documents without any time limitation with regard to those terms. That will be very burdensome to Minerva as well. And we're just trying to put a reasonable limitation to the discovery dispute here, Your Honor. And I think that theme goes throughout the disputes here today.

THE COURT: Very well. Thank you. Anything further?

MR. COHN: Yes, Your Honor. Two short points. If the search is done on the three engineers that we discussed earlier and it's a small volume of documents, then the burden is minimal. If it's a large volume of documents, then clearly it's not cumulative of what's been pulled before. And I think electronically they can pull out documents that

have Mr. Filloux's name on them and, therefore, very quickly have the computer determine what is new and not cumulative in that area. If it's small, there's no burden. If it's a lot, it's not cumulative and would be important.

The second issue on timing, Your Honor, Minerva limited their search to sales and marketing but among the people, the custodians to which Minerva is applying this time limitation is Mr. Clapper, the President and CEO, the Director of Marketing Mr. Pendlebury, the Chief Operating Officer, so we're not talking about sales reps. We're talking about the principals of the company.

And clearly what Mr. Clapper was saying about the NovaSure in 2009 or 2008 in developing the Minerva product, those will be very important documents too as he was running the company. So our view is that those are not as a practical matter being limited only to sales reps or marketing activities post-approval but that the restriction on the date is being applied by Minerva to cover from more than that and that is what we oppose.

THE COURT: All right. I'm going to grant the Motion to Compel with respect to the additional custodians and with respect to the production of documents prior to February 1, 2015. In hearing the arguments and reviewing the papers, these three custodians may potentially have relevant information because of their position as engineers who worked under Mr. Filloux and may have relevant information that might not be generated based upon the searches that have been conducted and continue to be conducted through this time.

As was argued by Plaintiffs, if it turns out there's a very small number of documents, then that should not be a burdensome exercise and would reinforce that the searches that have been done to date have largely collected the balance of relevant or potentially relevant information from the custodians. If it turns out to be a large number of documents, then it may require some greater effort on the part of the Defendant to go through for purposes of privilege or other potential objections, but that would also indicate that they are not

cumulative of the search that's been conducted to date.

And in order to be sure that both sides have the information that is relevant with respect to the accused product and patents-in-suit, my ruling is to permit or grant the Motion to Compel with respect to the custodians and not limiting the time period to February 1, 2015 as the cut-off with respect to these three custodians.

The remaining part of the motion is moot as it pertains to Requests for Production 13 and 22 in that Minerva has indicated it is willing to run the terms NovaSure and the letters NS with a space before and after in conducting the search for relevant records, so that is my ruling with respect to Requests for Production Nos. 13 and 22.

Shall we move on to Request for Production No. 3?

MR. COHN: Thank you, Your Honor. So Request for --

MS. KIM: Your Honor, can I ask for clarification on that ruling?

THE COURT: Sure.

MS. KIM: With regard to the date February 1, 2015, does that apply to all of the custodians and not only the three additional custodians?

THE COURT: If the custodians who were important individuals in the company as Mr. Cohn has represented that that cut-off was placed primarily to affect the search for sales and marketing information, if these custodians have roles beyond that and were involved in the development of the product and running of the company, then that cut-off date does not apply. You should search for everything.

Certainly, these rulings that I make with respect to compelling discovery are without prejudice for the parties to come back and seek additional relief or if you encounter a greater burden than you anticipate with respect to the search, you can make a further application once you've met and conferred with counsel to see if you can further limit it. If you can't agree, you can come back to the Court; but I suspect that you're either going to find

very few additional documents because your additional searches have produced what is likely to be primarily relevant in the case.

If you find there is a large quantity of documents yet to be produced and for some reason it creates an unusual burden in going through them or you need additional time beyond the deadline set in the scheduling order for producing documents, that's a matter that the Court can address at another time.

MR. COHN: Your Honor, if I may indulge 30 seconds on that topic?

THE COURT: Yes.

MR. COHN: Hologic's position is that in terms of the custodians who would be more important than mere ongoing sales reps would be Mr. Clapper who is the President and CEO, the Director of Marketing, the Chief Operating Officer, the VP of Sales and Marketing and then the territory managers who manage the sales and assist in the sales strategies, so we think that documents before that date from those people would be important because they would be developing a strategy and a sales plan that

would then be implemented after the date and we can limit the date just to the sales reps. We just want it to be clear that the people that Hologic thinks should not be subject to the limitation are those that I just identified.

THE COURT: I will compel the production with regard to those individuals and as I said, these rulings are without prejudice for either party to come back and seek further relief or in the case of the Defendants further limitations on that depending on what's encountered when the search process is begun.

MR. COHN: Thank you, Your Honor. The next topic is RFP No. 3 regarding FDA materials. There are two categories of documents in this dispute. One is the design history file and the second is the complaint file. I'm actually going to start with the burden argument first, Your Honor, which is a little unusual in the discovery dispute. Minerva admits they have all of these documents collected in a filing cabinet, so in terms of burden they can get those and they're collected, so the burden on collection is extremely

minimal.

And the reason I have those, Your Honor, is the FDA requires medical device manufacturers to maintain these types of documents. So the question here is really one of relevance and these are highly relevant. The design history file, Your Honor, is at the center of every medical device patent case. It contains the official history of the product development that the FDA requires for traceability purposes so the FDA can go back and determine the state of the product.

This design history file we feel is going to be important, Your Honor, because Minerva has made statements in the FDA in other documents specifically regarding the NovaSure and the similarity to NovaSure. The NovaSure product is one of the products to which Minerva has compared itself in its FDA filings and we feel that the design history file will be important to review to see if there are more admissions in that regard.

THE COURT: If you know the answer to this, I'm going to ask Minerva as well. But,

Mr. Cohn, if you happen to know the answer to this, it's my understanding that Minerva has already produced the design history file. In your client's estimation, has there been less than a complete production and what reasons do you have to believe that the production is less than complete?

MR. COHN: Sure. So we've been told that they have produced documents sufficient to show the structure and the operation of the product. And a part of that is what Minerva thinks is sufficient may be a little different than what Hologic thinks is sufficient. In terms of understanding the product and how it works in its structures currently, I think we do have an understanding of that from the documents.

But in terms of how that product was developed over time, Your Honor, I'm not sure we have the complete picture. And that's important for two reasons. One, it's important to see whether they were steering into these patents or away from these patents. And in our paper we talked about one of the reasons the

design history file is important because it will explain why changes were made and how changes were made, whether they were difficult or not.

These things go to the damages proposition as well in terms of how valuable some of these features are. Reasons why they were made is also important, whether they were made for a customer benefit or a manufacturability benefit. Those are relevant to the damages aspect as well. Then of course the copying, the willfulness, to the extent that changes were made or unmade because of the NovaSure, because customers liked things the NovaSure has, we just don't know, Your Honor. But we feel that the answers to the questions will be in the design history file.

THE COURT: All right. And the complaint files?

MR. COHN: Your Honor, the complaint files are critical here. We should not forget that this case also involves claims by Hologic against Minera under the Lanham Act, false advertising and unfair trade practices regarding statements that Minerva has made in

the market about the safety of products.

Conversely, Minerva has asserted counterclaims that are similar alleging that Hologic has made false statements regarding the safety of the Minerva product. Now, for Hologic to defend itself against a claim that its statements that Minerva is unsafe or untrue, the complaint files is one of the clearest ways where Hologic could look at Minerva's own documents and say look at all of these complaints from customers. This shows your product is not safe and what we said about it is not false.

THE COURT: Hasn't Hologic made its pitch, so to speak, to Judge Robinson for this type of discovery in connection with the preliminary injunction motion and didn't Judge Robinson find that it is not to be produced?

MR. COHN: She did in the context of the preliminary injunction motion, that's true. It's unclear exactly why Judge Robinson did that. I think the opinion was brief in light of the preliminary nature of those proceedings. I think that Judge Robinson was

trying to keep discovery circumscribed as possible given that it was at the beginning of the case. Frankly, both parties had been engaged in a lot of discovery and I think the judge at that point was trying to keep things from expanding further. I'm not sure that Her Honor questioned the relevance of the documents to the case as a whole, but at that point in the case I think Judge Robinson didn't feel that they were relevant for the injunction.

THE COURT: Well, let me ask the direct question that perhaps wasn't covered or maybe it was. It would be helpful for me if Hologic would explain why the complaints which are publicly available from the FDA are not sufficient to satisfy this request?

MR. COHN: That is critically important and perhaps that issue was not explained to Her Honor in the previous ruling as clearly as it should have been by me and us. The complaints that are published to the FDA site, Minerva makes a decision whether or not to do that. We believe that far more complaints come into Minerva than are published.

There is a protocol in terms of what complaints must be published publicly and what don't. Minerva makes that decision. Hologic feels based on its experience with having acquired Novasep and seeing the state of Novasep's reporting policy when it stepped into the company and knowing that the same people at Minerva are running that, Minerva is not publishing the kinds of complaints it should be. That's Hologic's position.

Hologic feels that there will be documents in Minerva's files reflecting other product safety issues that Minerva is not publishing, so the public record on these complaints, Your Honor, is very thin. There are one or two a month that are being published. Our sales force at Hologic provides far more evidence of issues that are out there and not being published. So our own sales people, Your Honor, are giving us evidence that there may be more complaints in the documents at Minerva than we're seeing in the public record.

Again, Your Honor, we don't really know what's there because they haven't produced

it. If we see their complaint files, their intake, there's a 1-800 number that doctors can call, there are emails that doctors make to the sales reps complaining about the product, if Minerva determines that it was the doctor's fault and not their fault and maybe they feel like they don't need to publish it, it's not necessarily our client's policy, but I think we feel that those documents could be highly relevant if there are a lot of them. And if there are not a lot of them, then the burden will be very low. So again, similar to the last issue we think that those documents at discovery should be had of those so we can at least see what's in there.

THE COURT: All right.

MR. COHN: Thank you, Your Honor.

THE COURT: Ms. Kim?

MS. KIM: Your Honor, with regard to the design history file, there is a regulation under the FDA where Minerva has to keep all of its design files whether it's significant or not and Minerva keeps that in hard copies. There are probably more than 12

feet of these printed copies of documents and that's what Hologic is asking Minerva to produce.

We have already produced research and development documents, the design of the Minerva product and in particular we've produced documents that show any differences that Minerva has in its current generation to product from its original design which is a Generation 1 product which was submitted to the FDA. In other words, the document details any differences that were made to the product so Hologic has all of the information that it needs with regards to any design changes and research and development for the product itself. They do not need this 12 feet of hard copies of documents --

THE COURT: How does the Court weigh in on its determination of relevance that's made by a party? I can accept your representations. But beyond that, there's nothing in the record necessarily to support that or give the Court a comfort level that a party who is making its own determination of

relevance of what to produce is producing all relevant documents, and I say that without suggesting or implying that there's any dishonesty or deceitfulness or wrongdoing on the part of counsel.

I'm just saying that people in some respect when you're on both sides of a litigation have different impressions of what is or is not relevant and ultimately, the Court makes the decision I suppose when there's a dispute. And if you're telling me that there's a 12-foot high pile of documents, then certainly that could be either internally copied or outsourced.

And if the burden and expense of doing that is a factor, then that's something that the Court can address through cost-shifting by making the requesting party pay for paper copies. That application hasn't been to me and I don't have anything in front of me to support what the cost of doing that would be, but I leave that open-ended.

I'm just concerned about how I am to weigh in on one party's good faith

representations to the Court that we've given them what's relevant without allowing them to weigh in or the Court to weigh in on what's relevant.

MS. KIM: Your Honor, the documents that we have produced that are pertinent to this case are the documents that were submitted to the FDA in order to get approval, so there are a lot of different regulations and the detailed descriptions that we have provided to the FDA which included the historical design changes and kind of explaining the research and development of the product.

And that's called the PMA application, the premarket approval application, and those documents sufficiently show the information that Hologic is seeking that relate to copying, willfulness and others because it does show the historical design changes that have happened and that is already available to them, and these were documents that were submitted to the FDA.

Your Honor, as to the cost-shifting issue, to the extent that the

Court grants its motion for us to produce all of these hard-copied documents, as for the cost-shifting issue, we may ask for that, Your Honor.

THE COURT: It's without prejudice and you're free to do that.

MS. KIM: The second issue is the complaint files and this was an issue that we already went to the Court a few months ago in front of Judge Robinson. As to the complaint files, the FDA requires Minerva to keep every single complaint regardless of how trivial the complaint is and they keep that in hard copy. Minerva is then required to report certain complaints and recently the FDA actually audited Minerva with regards to the complaint files and found that Minerva is properly reporting the complaints that they have to report to the FDA database.

Judge Robinson had held that in regards to the safety issue that the FDA has already determined the safety and efficacy of the product and it's not privy of the Court to look at that issue. And also, the FDA has

already determined that Minerva is properly following the regulations to report the complaints. And for Hologic to say that they believe Minerva isn't doing that, that's not in their purview. The FDA has already audited and approved the process that Minerva is doing already.

THE COURT: Very well. Anything further, Mr. Cohn?

MR. COHN: If I may briefly, Your Honor. The first topic, the design history files, the PMA, the premarket approval application that Ms. Kim referred to the description of the design history, the changes are very summary. It's not a highly technical description that would be in a design history file. It doesn't provide the technical detail, it doesn't apply to reasons why changes were made or how they were made.

With respect to the complaint files, the public database -- again, as I said it just has a few entries a month versus we're talking about a pile of documents, so right there you see a very large difference between

the complaint files that Minerva has versus what has been made public.

And the key there, Your Honor, Ms. Kim kept referring to complaints that they have to report. There are many other complaints that maybe they don't have to report under the regulation which does not make those irrelevant to this case. It makes them highly irrelevant if there are a lot of them. I think Hologic should be allowed to inspect those and have its experts opine on how important they are.

Lastly, Your Honor, with respect to your question regarding Judge Robinson's ruling, the PI was directed to the patent issues. Minerva had a PI directed to unfair competition issues. There was no discussion of damages at all and I think that for a product that may have a lot of complaints about it, other kinds of safety issues that may be tarnishing the reputation of Hologic's brand, that those would be relevant to the damages calculation for Hologic's claims, both its patent claims and also for its unfair competition claims, how much is our brand being

hurt by the problems that Minerva's product has. So for all of those reasons we think that the complaint files should be discoverable at the least. Thank you.

THE COURT: So my ruling on this is I'm going to order the production of the hard copies of the design history files, and that's without prejudice to Minerva to make an application to the Court if it decides to do such regarding shifting the cost of reproducing what I've heard is a 12-foot stack of hard copies of documents, shifting the cost to Hologic. I'm not ruling on whether or not I will order a cost-shifting. I'm just making this ruling without prejudice to make the application.

However, with respect to the complaint files, I'm just not satisfied on this record to go in a path differently than what Judge Robinson did, and I realize that the scope of her ruling was narrowly focused at that time on the issues that were important to consideration of the application for preliminary injunction. But nonetheless, complaints are

publicly available from the FDA and production of that should be sufficient to satisfy this request.

If it turns out through review of other documents that there are important complaints that perhaps are not publicly recorded that are in the files of Minerva and may be relevant to issues in this case, it's without prejudice to ask me to reconsider this. But on the present record, I'm not satisfied to go beyond what Judge Robinson has done and what is publicly available with respect to complaints from the FDA.

I'm not sure how it would be relevant and proportional to the needs of the case to have Plaintiffs review every single documented complaint that Minerva has kept and do its own auditing and policing of whether or not those should have been passed along to the FDA, at least not on this record right now.

All right. Shall we move on to Request For Production No. 20?

MR. COHN: Thank you, Your Honor. Document Request No. 20 asks for documents

relating to the conception, design and development, R&D evaluation and testing of the Minerva device. I think the objection has been that they have provided documents sufficient to show the structure, function and operation.

But again, this doesn't show the direction that Minerva took to get to that structure, function and operation, what they relied on to get there, whether they looked to the NovaSure and to what degree in order to develop the structure, function and operation.

We think that these documents are critical for the copying and willfulness story so that we can explore the genesis of their product, where they got the ideas for this structure, function and operation of their product and how they went about trying to implement those. We feel that these products are the kinds of products that are standard in any patent case and the documents sufficient to show how the product currently functions don't give you the story about how the Defendant got there in the first place. In the copying case, Your Honor, I think these documents are central

to that inquiry.

THE COURT: Your request seeks, at least I'm looking at your letter brief Document Item No. 164 on Page 3 where this is discussed that Request For Production No. 20, and it says Hologic requests the research and development documentation for the accused Minerva device.

Research and development documentation is a broad category. I'm hearing on the other hand from Minerva that it has produced documents that satisfy this request. What is there before me that allows me to test the sufficiency of the production and/or determine that less than a complete production has been made by Minerva?

MR. COHN: Your Honor, just based off what Minerva said in its response to the letter brief, the only example that they give for documents relating to research and development is the PMA application and its supplements. That PMA application and its supplements describe the structure, function and operation of the product, but it doesn't describe how they got there.

For example, Your Honor, it doesn't describe perhaps failures that happened in R&D. Perhaps they tried to design around some of the key features and they undertook testing to do that and they determined that they needed the features that the patent claims so they wouldn't be in the PMA and they wouldn't be in the documents that at least Minerva has told us they produced yet.

THE COURT: Where would they be? Would they be in the production of records custodian? Would they be in some other category of requests for production that are included in your set. It's too general. I'm trying to get more granular on this than just a general request for "R&D documentation."

MR. COHN: I would expect them to come from the custodians, the engineering custodians, and frankly, Your Honor, from the three custodians that we just discussed earlier that Your Honor compelled the discovery from regarding NovaSure. This is a small company, Minerva, and they had a very well-defined research and development group.

I think if Your Honor is asking me how we can limit this request, I would say that we can limit it to the features that are accused of infringing so the cavity assessment test and how Minerva conducted its R&D regarding assessing for perforations, whether they conducted research and development on how to remove moisture from the cavity, research and development regarding the shape of the applicator head. These are features in the claims of the patents, Your Honor.

And I do want to keep this as narrow as possible, but having not knowing what they worked on and not knowing what's there, it's hard to say. I can imagine a number of tests that were done or that may have been done to the product to try to do things that it doesn't do now and I wouldn't know if those exist and Minerva's effort to try to do those things could establish that they need the accused features and that it was not another way to do it. I just don't know, Your Honor, because I don't have the discovery.

I would submit that even a broad

request as documents relating to the research and development testing and evaluation of the accused product is not overbroad. That is the kind of materials that Minerva would keep in its engineering group and would have archived and produced. Is it a lot of documents? It may be a lot of documents, Your Honor, but those are the kind of documents that get produced routinely in these patent cases so we can explore the how and the why of the product development and not merely the endpoint of what is the product today.

THE COURT: Very well.

MR. COHN: Thank you, Your Honor.

THE COURT: Ms. Kim?

MS. KIM: I think the RFP No. 20 is now moot in light of your order today concerning the design history file as --

THE COURT: I was just going to ask if there was any overlap in that.

MS. KIM: And in addition to Mr. Filloux and others, you have ordered us to produce the three custodians using the search terms NovaSure and NS and also we're producing

and searching for any documents or emails from other custodians relating to the patents-in-suit, so I think RFP No. 20 will be covered under all of the documents that you've compelled us to do today.

THE COURT: Very well. Mr. Cohn, do --

MR. COHN: I have nothing further.

THE COURT: I'm going to deny it without prejudice. I will permit Hologic to ask the Court to reconsider this if after receiving the documents that are being compelled for production today and other documents that Minerva was going to supplement in the normal course, in any event that if there is still a concern or you have a basis based on what you're seeing in certain documents there's a basis to believe that documents have been held back which are responsive to this particular request for production relating to the how and why of product development as you've described it, then I will reconsider the application at that time.

Are we ready to move on to Requests For Production Nos. 31 and 33?

MR. COHN: Yes, Your Honor. Requests Nos. 31 and 33 seek documents regarding Minerva's efforts to design around the NovaSure device and then descriptions of embodiments in patent applications that led to the asserted patents, so these asserted patents are children of a larger patent family that extends back into the 2000s before Minerva had come out.

There is testimony that we provided in the course of the PI proceedings that Minerva was aware of the patent applications that led to asserted patents so they knew about this family before the patents-in-suit came around. So Hologic is asking for documents that reflect efforts to design around descriptions in those applications even before the claims in this case issued, and that's relevant because there may have been other claims directed at the same features and I think it shows a pattern of behavior of knowledge of our patent portfolio and I think to limit it only to the particular claims that have been asserted would not capture the full scope of the knowledge of Minerva. We think that

limiting it just to these claims could cut out a significant portion of potential evidence.

THE COURT: All right.

MS. KIM: Your Honor, RFP Nos. 31 and 33 go to Minerva's effort to the design around and we have already agreed to search and produce documents relating to designing around the patents-in-suit and the issued claims of the patents-in-suit which is the relevant issue for the design around. Now, they are asking for the so-called design around of patent applications and related patents are not at issue in this case and they cannot really explain what the relevance of any such efforts would be. There's no relevance to that, Your Honor.

The issue in this case is infringement of the claims that were issued for the patents-in-suit that was in the case. It's not about the related patents and it's not about any claims that were not issues during the prosecution of the patents-in-suit, so we see no relevance to the claims or any issues in this case for us to go and search for any such documents.

THE COURT: Plaintiffs point out, however, that in other discovery responses Minerva admits that it was aware of the application that led to certain of the patents-in-suit, so why wouldn't design around efforts with respect to those applications for the patents-in-suit potentially lead to relevant information and isn't such a request proportional to the needs of the case?

MS. KIM: Your Honor, the knowledge that there was application out there, they already know about that and that information was provided to them. But the issue is the design around of changing the Minerva accused product and the applications or the related patents are not at issue for infringement. The only issue for infringement is the patents-in-suit and we've already agreed to produce any documents that go to the patents-in-suit and design around of any of these patents-in-suit.

We do not understand how -- you're not infringing on patent applications. There is no such designing around that is relevant to

this case. Same thing with the related patents, there are at least five related patents. Any effort to design around the related patents have nothing to do with any of the claims or issues in this case. The case is about infringement of the patents-in-suit that they asserted.

THE COURT: All right. If you can respond to Ms. Kim's last comment along with anything else you want to bring to my attention.

MR. COHN: Sure. Very briefly, Your Honor. At the least, design around efforts for other patents in the family we show a pattern of design around. They design around other features but not these patents; that shows that these features in this case are pretty important. They usually design around features but they didn't design around the features in this case.

They never designed around any of Hologic's patents, even the other ones that show what we would consider a willful disregard to our patent portfolio, and another standard Minerva practiced that I think is relevant to the willfulness inquiry. Lastly, I think

Ms. Kim suggested you can't design around the patent application. Of course, you can. Companies do this all of the time. They look at pending applications. Whether there's claims there or not, you can ask yourself whether an application would support claims that could be prosecuted and whether you want to try and develop into that description or not. That happens all of the time as well. Whether Minerva has done this on these patents or other patents is highly relevant to the willfulness inquiry in this case.

MS. KIM: I just wanted to point out the timing of these applications in the patents. So three of the patents were issued in 2015 and 2016. Minerva's accused product essentially had all of their designs set by June 2011. We've told Hologic that Minerva became aware of the applications to these patents around 2014. So there was no relevance here, Your Honor, because the relevant functionality in features was pretty much set by June 2011.

And there was one more patent, the '183 patent, which was issued in 2005 even

before Minerva was founded. So any knowledge about the application for the '183 patent is irrelevant to the case.

MR. COHN: Your Honor, if I may, Minerva has been aware of the whole patent family from the beginning of this. Mr. Truckai is the leading inventor of these patents so they've known about these applications that have supported the claims asserted in this case.

I don't understand the comment about the '183 patent being issued in 2005. Clearly, any efforts undertaken to design around that patent or related patents would be relevant to the willfulness inquiry. So the fact that a patent claim has not been asserted in this case doesn't mean that efforts to design around it are irrelevant. They are irrelevant.

They show a pattern of behavior. They show the standard of conduct at Minerva and Hologic should be able to explore that and allow the jury to test that pattern and answer whether it's willful. Thank you, Your Honor.

THE COURT: Thank you. I'm going to grant the request in part and deny it in

part. Documents reflecting design around efforts relating to the applications leading to the patents-in-suit I'm ordering to be produced. They may be relevant to the issues that relate to scope of knowledge, willfulness, et cetera. But with respect to design around discovery as to what I believe are the six related patents, I'm not thoroughly convinced that that would be relevant and proportional to the needs of the case, even if it is relevant.

Again, I make this ruling without prejudice. If you can make a showing at a future time that design around discovery should be compelled with respect to six patents that are not the patents-in-suit but are in the family of patents, then I'm leaving that open without prejudice. But presently, I will just limit this ruling to the patent applications for the patents-in-suit.

Let's move on to Request For Production No. 32.

MR. COHN: Thank you, Your Honor. I suggest this one will go quickly in light of Your Honor's last ruling. Request For

Production No. 32 seeks analyses and studies of documents involving comparisons between Minerva and claims of the asserted patents for their patent applications and the same objection was made that they agreed to provide some materials relating to the patents-in-suit but not to the applications from which those patents came, and I think Your Honor's prior ruling should apply to this as well, that those other analyses to the applications in the family should be produced.

THE COURT: All right. Ms. Kim?

MS. KIM: Your Honor, in light of your ruling on our RFP Nos. 31 and 33, we agree with opposing counsel on that same issue.

THE COURT: All right. Then I will apply that ruling and extend that ruling to Request For Production No. 32.

The next one I believe is the pricing information Request For Production No. 23.

MR. COHN: Your Honor, the way that these companies work is that they do sometimes sell products one at a time to doctors

on a la carte or ad hoc basis, but very frequently they will enter into contracts that last for certain amounts of time with certain institutions, physician groups, hospitals, hospital purchasing, HPGs and other groups. The larger the group, generally the larger the order. There may be discounts. Suffice it to say that these are the kinds of documents that are routine in producing the patent.

Now, Minerva responds that they have produced their financials from an aggregate level, the top average sales price and they've also shown sales to particular customers and what that customer paid. What that data doesn't show, Your Honor, is the discounts that had been offered so we don't know if the sales price that Customer X has paid was the rack price that was offered and they took it or there was a negotiation that went on and they paid -- there was a discount. It's difficult to tease that out from the documents that have been produced.

There may be non-monetary parts of the agreements, Your Honor, that could affect the value, for example, commitments only to

purchase Minerva products or a certain percentage of their needs from Minerva versus competitors. There may be other practices in terms of commitments to purchase other kinds of products or services and --

THE COURT: Well, Minerva has already said it's doesn't bundle it in a product. I believe that's what Minerva has argued. One of the things it's argued in its response, the only product Minerva produces it cannot be bundled with another product if that's what you're getting at.

MR. COHN: That's not what I'm getting at. I guess what I mean, Your Honor, is that there are different parts of the Minerva system, and the way that those parts are sold is relevant to the value proposition. There's certain capital equipment. Sometimes it's sold and it sits in the doctor's office and then it's used for all the different procedures.

There's a razor and blade model, Your Honor. There's capital equipment and then there's all of the disposables, and how the customer pays for that in various ways is not

always reflected in the top document. Some of the capital equipment is given for free to the customer and then they pay a higher rate for the disposable over time. Sometimes the capital is purchased and then that customer may pay a lower price for the disposable or not. We wouldn't know without seeing the agreement, Your Honor.

Some customers don't buy the capital equipment at all. They might lease it. They might borrow it from the sales reps. We just don't know without seeing these agreements. Also, Your Honor, the time commitment that the agreement might contain could affect -- there's a three-year agreement versus a six-month commitment which would affect the price and that's something that the damages expert would need to tease out in order to come to an accurate damages figure.

So it's really the non-monetary provisions of these agreements in addition to some monetary figures like discounts and things like this that may not be apparent from the top line numbers. Your Honor, we suspect that these agreements are kept in a pretty discreet

location at Minerva and could be collected and produced easily, so we would request that they be produced.

MS. KIM: Thank you, Your Honor. As we indicated in our briefing, Minerva has a form agreement which is not changed by the sales representatives and we have produced that form agreement and these are the same. It just changes the customer's name. There's no use for Hologic to get those agreements.

In addition to that with regards to the price issue, Minerva has produced the average sales price for each month. It also produced a list of all the discounted disposable, so we have two parts to the system. One is the controller. The other one is what we call the disposable which is the hand piece part. The controllers are rarely sold by Minerva. These are loaned out and we also produced lists of all of the loaner controllers that we gave to the customers. They have that information.

There are not a lot of instances of discounted disposables and they have a list

of all the disposable prices and how many units each customer buys on these prices. They also have a total sales volume information which has the total revenue from each of the customers. With regards to all of that information, they have all of the information they need with regard to whether any disposables were discounted and for which customers.

THE COURT: Mr. Cohn?

MR. COHN: Sure, Your Honor. I'm not sure that the information we have shows discounts customer by customer. Again, I think it's all rolled up so it will be hard to evaluate the value of any particular transaction with simply rolled-up figures. I would say I heard from counsel that the form agreement that Minerva uses never changes. I'm not imputing counsel's honesty, but that's not evidence that Hologic can rely on in the case. So I think the whole point of discovery is that we get to see the evidence and figure out if that's actual or not.

I think in our brief we had proposed a compromise of a representative sample

of 20 agreements to address the burden issue so we can see whether they are all indeed the same or whether there's any differences or anything like this. But we would submit that the rolled-up figures that we were provided and then counsel's assertion that the form agreement never changes is not sufficient for us to prepare the evidence that we would need to prove our case.

THE COURT: Ms. Kim?

MS. KIM: Your Honor, I'm not sure what counsel means by rolled-up figures. I have an exemplary document which they used in a deposition which shows by each customer the discounted disposable and the price and how many units they bought so I'm not sure what he means by rolled up. We have produced very specific information with regards to discounted disposables.

With regard to the form agreement, they can confirm with the witnesses when they depose our sales representatives to see whether there are any other sales agreements that's followed by the form agreement. It's our

understanding that the form agreement is never changed.

THE COURT: On this particular request for production, I'm going to grant it in part and deny it in part. The part that I will grant is I will order Minerva to produce the compromise, that is, the 20 representative agreements including five agreements from each of its sales territories. And this is without prejudice that upon review of those agreements if this matter Request No. 23 needs to be addressed further in that Hologic wants to compel further information with respect to pricing discounting sales, form agreements, et cetera, that it is without prejudice to come before the Court once it has the representative agreements they can make that application.

MR. COHN: Your Honor, if I may at the risk of pressing my luck?

THE COURT: Sure.

MR. COHN: If I could ask, we heard a representation that there are no agreements different than the form agreement. Can we ask that if there are such agreements

that have non-monetary provisions different than the form agreement, that those be produced? If the representation is there are none or maybe there's one or two that -- I just want to make sure that if there's anything different than that form, that they will include it in the samples.

THE COURT: Ms. Kim, do you want to speak to that?

MS. KIM: Your Honor, I'm sorry. It is the proposal that we only produce the agreements that are different or that we produce the 20 representative agreements but include in those any changes that were made?

THE COURT: It's the latter, you produce the 20 representative agreements and make sure that you include any agreements that would show either the non-monetary parts of the agreement or changes from the standard form agreement in light of your representation that Minerva always uses this form agreement and never changes it.

If there should be agreements which are not consistent with that

representation, even if there are only a few, they should be included in the representative sampling so that Plaintiffs can explore that issue.

MS. KIM: Your Honor, I think it would make more sense for us to go and see if there are non-monetary changes to any agreements and produce only those that are different from the form agreement. I don't see any reason why we would have to produce representative agreements in addition to looking for any changes that were made to the form agreement. We have to do this exercise anyway. I do not see the need for them to have the additional representative agreements which are the same as the form agreements.

We're willing to go and search and see whether there were any changes made to the non-monetary provisions and if so, we will produce those agreements.

THE COURT: Very well. Mr. Cohn, do you want to speak to that?

MR. COHN: Sure. I think the point of asking for samples was for us to

confirm that the table that Ms. Kim had shown provides all of the information that we need. If we get the 20 samples and five from each territory, okay, we can correlate all of this now to the form agreement and all of the data that we have in that table, I think we will be satisfied but I feel that the samples will be necessary for us to do that.

THE COURT: I'm going to permit the sampling as well. I think that would put to rest the questions that Hologic has. It's not a burdensome exercise to ask Defendants to produce the representative agreements even if it turns out that they are identical to the form agreement and also to produce those agreements in which changes from the form agreement, so the non-monetary parts of the form agreement.

Again, the ruling is without prejudice for the parties to come back before the Court with respect to that particular interrogatory and anything that may be generated by the search for documents responsive to it.

All right. Request For Production No. 10.

MR. COHN: So Request For Production No. 10 seeks marketing plans, strategic plans and/or business plans regarding commercialization of the Minerva system. I think Minerva has committed to get us the first of those, the marketing plans. They provided that they will "produce documents that reflected sales and marketing plans and product positioning including marketing pieces provided to physicians, patient brochures sales training handbooks and marketing plans."

I think we should also be seeing strategic plans or business plans that might not be strictly directed at marketing but other aspects of the development and commercialization of the Minerva product in terms of changes they might wish to make to the product, forecasts, sales forecasts, things like this that might be in a -- we're just concerned that there are business plans and strategic plans out there that might be excluded by Minerva's response.

If they get up and they say we're giving you strategic plans and business plans too and not limiting you to what a "marketing

plan is," then I don't think we would have a dispute. But I think our concern is that there are strategic commercialization plans, documents that reflect commercialization of the product that are somehow being excluded by this answer in the discovery responses.

So to summarize that, we're after the strategic plans and the business plans in addition to the marketing plans.

THE COURT: Very well. Ms. Kim?

MS. KIM: Your Honor, I thought that the real dispute was they were planning that we did not complete "actual plans themselves" and as Minerva is a small company there is no "business plan," but we tried to gather documents that reflect such things that would reflect the sales plans, marketing plans and product positioning to hopefully include the information that Hologic is seeking.

I am not quite sure what they are looking for other than what we've already searched for, because there's no actual thing that's called plan or business plan, but we did search for anything that would reflect such

things such as product positioning, sales and so forth.

THE COURT: Mr. Cohn, anything further?

MR. COHN: I've never heard of a business that doesn't have a business plan. I don't know what to add to that other than to ask that they be compelled to produce business plans and strategic plans. And if they have done that, then we can confirm that with witnesses down the road. If they haven't done that, then they should. As our view in light of counsel's comment, that would factor in favor of granting this motion and we will look at the documents that have been produced.

THE COURT: Very well. With respect to this particular interrogatory, I'm always in a quandary as how I compel a party to produce something that they tell me they've already produced and there's nothing more.

Just for purposes of clarification should that be the case I would ask that Minerva make sure and double check its previous search for responses to this particular interrogatory

to be sure that if there are strategic commercialization plans and business plans in addition to marketing plans and anything along those lines that might be responsive beyond what has already been produced, that supplement its response, and that's the best I can do under these circumstances without prejudice to Hologic to come back to the Court and demonstrate how the production remains incomplete beyond some speculation that most businesses have this, therefore, Minerva must have this.

I need something more concrete than that, that will demonstrate that these materials were held back either intentionally or inadvertently if that's the position Hologic takes.

MR. COHN: Your Honor, I think our concern was that we had asked for marketing, business and strategic plans and their answer said we will give you marketing plans. If they amend their answer to say we will give you marketing, business and strategic plans to the extent we have them, I don't think we will have a dispute, Your Honor.

THE COURT: I will ask that they supplement their response to be sure that they have made an adequate production to make a Request For Production No. 10 and we will take it up at another time if there is an issue with respect to the sufficiency of that response.

All right. The last interrogatory, the clinical trial before FDA approval Interrogatory No. 7.

MR. COHN: Yes, Your Honor. We asked Minerva to identify all of the clinical trials and clinical studies they had done before FDA approval and I think their response was that they would limit it only to the clinical studies they actually submitted. Obviously, Your Honor, if there were other studies that provided poor results or any different results, that we should at least know what they are so we can determine whether there's something that's important to the case.

I think that if the product didn't perform differently in other studies, that's something that was highly relevant and I don't think there's a dispute about that. I think the

core of Minerva's objection is that the studies referred to an earlier product, the Gen 1 product that they didn't launch, just the Gen 2. But the Gen 2, the regulatory approval for Gen 2 was based on the studies that were done with the Gen 1 product. And our concern is that that was only a subset of the studies that had been performed.

We asked for an identification of what other clinical studies had been done on the product so that we could then seek discovery on those to determine that we had a complete picture of the clinical history of the product. I don't think there's an allegation or assertion regarding burden on this. I think the allegation is one of relevance, but I think that the clinical performance of the Minerva product is clearly something that is relevant in this case in terms of its function and operation in the clinical environment.

THE COURT: Very well. Ms. Kim?

MS. KIM: Your Honor, Minerva's position is indeed that these are irrelevant under the safe harbor provision. But in any

event, all of the clinical trials that have been done by Minerva, Hologic has that information through the PMA application that we produced. I can confirm that Minerva did not do any other clinical studies other than what was approved by the FDA and what was audited by the FDA and all of those clinical trials are detailed in the PMA application.

So in light of that, Hologic already has that information and I think this request is moot.

MR. COHN: Your Honor, if I may, if Minerva's position is that they have produced documents that give us the answer, then they should amend that answer to rely on Rule 33(d) and then they would need to follow the strictures of Rule 33(d) which is that they should point us to those documents by Bates Nos. which I don't think they have done.

So if that's their response to this interrogatory, that they can 33(d) us and refer us to the document production, I would suggest they need to do that. But simply not answering -- they produced the documents so

clearly it's relevant. They should answer the interrogatory in the appropriate manner, Your Honor.

MS. KIM: We're happy to do that under 33(d) and identify the documents.

THE COURT: All right. Very well. In light of the representations on the record, I will order that Minerva respond pursuant to Rule 33(d) and provide a supplemental response.

How much time do you need to do that, Ms. Kim?

MS. KIM: Your Honor, we can provide that in two weeks.

THE COURT: Okay. Very well. I think that concludes all of the issues that were before the Court in dispute. Are there any further matters that counsel for the Plaintiffs would like to bring to the Court's attention at this time?

MR. COHN: Not at this time, Your Honor. Thank you for a long day.

THE COURT: Okay. Very well. Anything further, Ms. Kim, that you would like to bring to the attention of the Court?

MS. KIM: No, Your Honor.

THE COURT: Very well. I thank counsel for their stamina and endurance today and for being succinct with respect to these specific requests for production and interrogatories that were in dispute. I think that covers everything that we needed to accomplish today. I will also thank the representatives from the different parties for being here as well. We are adjourned.

(The proceedings ended at 4:30 p.m.)

CERTIFICATION

I, Taneha Carroll, Professional Court Reporter, certify that the foregoing is a true and accurate transcript of the foregoing proceeding.

I further certify that I am neither attorney nor counsel for, nor related to nor employed by any of the parties to the action in which this proceeding was taken; further, that I am not a relative or employee of any attorney or counsel employed in this case, nor am I financially interested in this action.

/s/Taneha Carroll
Taneha Carroll

Professional Reporter and Notary Public

EXHIBIT K

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

HOLOGIC, INC., et al.,)
A)
Plaintiff,) C.A. No. 15-1031-SLR-SRF
)
v.)
)
MINERVA SURGICAL, INC.,)
et al.,)
)
Defendant.)

Wednesday, June 21, 2017
12:30 p.m.
Room 6100

844 King Street
Wilmington, Delaware

BEFORE: THE HONORABLE SHERRY R. FALLON
United States District Court Judge

APPEARANCES:

YOUNG, CONAWAY, STARGATT & TAYLOR, LLP
BY: SAMANTHA WILSON, ESQ.

-and-

ARNOLD & PORTER KAYE SCHOLER, LLP
BY: RYAN J. CASAMIQUELA, ESQ.

Counsel for the Plaintiff

APPEARANCES CONTINUED:

ROSS, ARONSTAM & MORITZ, LLP
BY: BENJAMIN J. SCHLADWEILER, ESQ.

-and-

WILSON, SONSINI, GOODRICH & ROSATI, P.C.
BY: OLIVIA M. KIM, ESQ.

Counsel for the Defendant

THE COURT: All right. Good afternoon, everyone. All right. Let's start with a role call. Who is on the line for Hologic?

MS. WILSON: Good afternoon, Your Honor. Samantha Wilson from Young, Conaway, Stargatt & Taylor on behalf of Plaintiffs and I'm joined today by our co-counsel, Ryan Casamiquela from Arnold & Porter Kaye Scholer.

THE COURT: Okay. Very good. And who is on the line for Minerva?

MR. SCHLADWEILER: Good afternoon, Your Honor. Ben Schladweiler from Ross Aronstam stamp on behalf of Minerva and I'm joined today by Olivia Kim from Wilson Sonsini.

THE COURT: Good afternoon, everyone. Well, I have read the submissions. This is Plaintiff's application for an order compelling production of certain lab notebooks, so let me hear from the Plaintiffs and then I'll here from the Defendants.

MR. CASAMIQUELA: Thank you, Your Honor. This is Ryan Casamiquela on behalf of Hologic. So what we have here is, you know,

we're moving to compel the lab notebooks. And basically these lab notebooks had been put at issue specifically by Minerva in their interrogatory response they identified 25 issued patents and in addition to that, 24 pending applications relating -- and they are going to argue that these 25 plus 24, almost 50 total patents and patent applications cover the accused product, the Minerva Appalachian System. And it seems like they want to argue in front of the jury that these are novel inventions and that they developed the technology themselves. Our position is that they, in fact, designed around the Novasure technology. As Your Honor compelled a few months ago, we were looking for the term Novasure as a search term across different documents. Now, of course Novasure was a run across the lab notebooks because they're hard copies, they're hard copy materials. And so we're looking to get the lab notebooks to address both their contentions about how they allegedly invented almost 50 inventions, related to the conception and reduction to practice of those items and also,

you know, relating to their design-around of Novasure.

And then also they have this theory of undue experimentation. So this is in their invalidity contentions they argue that our patents are invalid based on the theory that they conducted an undue amount of experimentation on the accused product. And so we want to test that contention as well. And we want to look at the lab notebooks and see what type of undue experimentation actually happened. So it's just really about testing the contentions.

You know, I think it's pretty clear that these are highly relevant. Minerva essentially agreed to produce four custodian -- a very limited set of notebooks, specifically four custodians from the inception of the company to July of 2014. And so they're willing to do that or at least they offered do that a day before our brief was due. But we think that that's a very limited set of materials and we were looking for basically the lab notebooks relating to the development of the accused

product.

THE COURT: Let me ask you this. They say in their responsive brief, they being obviously Minerva, that significantly the design and functionality of the accused features of Minerva system did not change since early 2011. State for me, Mr. Casamiquela, why Hologic needs lab notebooks through June of 2014.

MR. CASAMIQUELA: Sure, Your Honor. That's a good question. So their interrogatory response lists, lists 25 patents, 14 of which were filed between 2011 and 2014. And then they have -- they list another 24 pending applications, 16 of which were filed between 2011 and 2014. So we're looking at 30 patents and patent applications that were filed between 2011 and 2014. That's number one.

Number two is that Minerva continued to design their accused system. They had a generation one. Generation one was, was worked on between 2009 and 2011. And then they had generation two. General two, generation two was worked on between 2013 and 2014 and then they filed their application with the FDA in

July of 2014. That's when they filed for FDA approval, July 2014. And so we feel like -- and also they just happened to produce two pages of lab note --

So the reason why we even know about this is they produced two pages of the lab notebooks and those two pages are --

THE COURT: Yeah, I was going to ask that. I think that came attached to an e-mail and that's how your client determined it was worth pursuing these lab notebooks. Tell me a little bit about that, what the significance is of the two pages in your client's view.

MR. CASAMIQUELA: Right. So those two pages were dated June 2013 and July 2013. So those two pages were later in time. And we actually marked those at the deposition of the author of those two pages, Ms. Hilario, who was an associate engineer. We found those to be highly relevant because they talked about the accused functionality relating to -- if you look at those pages, Exhibit 4 and 5 --

THE COURT: Right. I have them in front of me.

MR. CASAMIQUELA: Yeah. They talk about the width. It's -- one of the allegations in this case is relating to the width -- whether or not the accused -- the accused product measures or indicates the width measurement. And so here they say the three dots and the four dots. One of the design-arounds -- our position is that the three dots is not -- their position is the three dots is not equal to three millimeters.

THE COURT: Okay.

MR. CASAMIQUELA: Okay. They're saying that three dots does not measure three millimeters, it's just a random -- it's just having three dots. It just shows it's a progression of the opening of the array.

THE COURT: All right.

MR. CASAMIQUELA: And so this document shows that the three dots does correlate to a measurement around three millimeters. And that's -- they're trying to design around -- our position is that they're trying to design around our patent because they're arguing that the three dots does not

indicate three millimeters.
THE COURT: I see. All right.
MR. CASAMIQUELA: Of a width.
THE COURT: All right. Anything further before I hear from Minerva?
MR. CASAMIQUELA: I don't think so, Your Honor. I think that's all for now.
THE COURT: All right. Very good. Counsel for Minerva.
MS. KIM: Thank you, Your Honor. Olivia Kim for Defendant Minerva. As an initial matter, the opposing counsel refers to the almost 50 total patents and applications that Minerva cited with regards to their own technology. However, those patents go to the whole product. What is relevant here is the accused features of the accused device, which relates to the invention of the patent in suit.
With regard to our defense to willful infringement and copy allegations, they go to what we did with the accused features, whether we copied the accused features of the patents in suit. And we have made out very specifically how we developed those features and

how Minerva filed patents describing and claiming those accused features. And they were all done in 2008 and 2009.
Similarly, with regards to our undue experimentation contentions, one of the evidence that we cite to to assert undue experimentation is that for the -- again, for the accused features what experimentation Minerva did with regards to that. And that goes to the same similar patents that were filed 2008 and 2009 time frame. And as you mentioned, Your Honor, the accused features were not made since 2011 and the reason for that is Minerva started doing clinical trials back in 2011 with approval from the FDA. After those clinical trials were done and they were successful, that's when Minerva was able to file a pre-market application to get approval from the FDA to sell and make the product that was tested in the clinical trials.
Now, they were generation one and generation two, but within generation one and generation two there were no changes made to the accused feature.

THE COURT: All right.
MS. KIM: Therefore, Your Honor, we are requesting that Hologic's request be limited so that it's proportionate to the need expressed by Hologic. And we are asking for two limitations; one is the time period. As we indicated, our contentions with regards to the independent development happened back in 2008 and 2009. And indeed our product, the accused features did not change since 2011.
Secondly, the relevant custodians. With regards to our contention of independent development of the accused features, there are two relevant custodians to that. Those are the inventors of the Minerva patents that describe or claim the accused features. One is Minerva's founder, Mr. Truckai, and the other one is one of the engineers, Mr. Toth. And so those two are the relevant custodians with regards to Minerva's contention.
In addition to that, Minerva was willing to expand the list to include the relevant discovery custodians that were identified during discovery. That includes the

10 custodians that Minerva was required to identify under the ESI order and to meet additional engineer custodians that Hologic move this Court to add during discovery.
THE COURT: Okay. Let me ask you, Mr. Casamiquela pointed out Exhibits 4 and 5 to the Plaintiff's submission, which are the lab notebook pages, I believe of one of the Minerva engineers, Estala Hilario. And these pages from her lab notebooks are dated June and July, respectively, of 2013 and they seem to, as arguably pointed out by Plaintiffs, address some measurements, the reference to dots allegedly referencing a form of measurement that may have relevance to the issues concerning the patents in suit; that is, the accused features of the patents in suit, so why shouldn't the limitation be through June of 2014 as requested by Plaintiffs?
MS. KIM: Your honor, this goes to just testing of the accused feature that's already developed and set. And it is just testing the PST feature, which is one of the technology that Minerva developed back in 2008

and 2009. And Estela Hilario is here just testing the measurements, the PST feature that's being accused in the case. The accused device that is being currently sold, the PST is already there. It has nothing changed since 2011 and Ms. Hilario is just merely testing the measurements, it appears, for the PST, the device -- the feature the device already has.

THE COURT: All right. Thank you. Mr. Casamiquela.

MR. CASAMIQUELA: Sure. I mean -- it's not merely testing. It's testing it to see if there's a redesign that could occur or if minor adjustments could be made. But essentially, that is the key allegation in this case. The key allegation is that the three dots do not indicate three millimeters. That is -- for one of the patents, that is the key dispute, for infringement and for design around. The whole copying or design around case is about the fact that they put dots instead of numbers. On our product we have three millimeters, we have the number three. They have three dots. And that's their design around. That's the whole --

that's our -- that's our -- that's one of our key positions on why we believe that they're just infringing our patents because they use dots instead of numbers. And so it's really highly relevant. And, you know, that's why we even brought -- that's why we brought the motion is because of these two pages and we believe there's a lot more out there. And so that's -- that's why we're here.

You know, again, I mean on the time limitation -- so Minerva has these two limitations, time and custodians. On the time limitation, you know, the key points are, again, they have -- in the rog response they actually assert 25 patents they say covers the accused device. And they have 14 -- sorry, they have 24 applications that cover the accused device. And 30 of those, together, are from 2011 and 2014. And so we believe the time limitation doesn't make any sense.

With regard to the custodian limitation, they argue that there are only -- well, they argue that there's two inventors or two custodians, but actually if you look at

those, those 25 patents that were filed, that they're -- and then you look at the 24 patent applications, there are 12, there are 12 named inventors on those, not two, 12, for all of those applications that they -- patents and patent applications that they list in the rog response. So we got 12 named inventors.

And then also on top of that, they argue that the founder, Mr. Truckai, he's the founder of the company, kind of like the lead engineer, he didn't have any notebooks. But the thing is is it's routine for like the executives and the founders, they don't want to do the notes, they delegate that to others. And so it's routine that may be the middle -- the engineers, the kind of the associate engineers, they are the ones that do all the note taking, not the head guy. And so, so he doesn't have lab notebooks, but all the people under him have lab notebooks, so we don't believe limiting it to just a few people makes sense. So we have the 12 named inventors, then we have people that were delegated under that.

And then we don't have any

argument on burden. There's no argument that it's hard to collect these lab notebooks. They don't identify any burden specifically. And we asked them in the meet and confer, how many notebooks are out there? They didn't tell us how many there were. And they didn't tell us in the briefing how many there were. For all we know there's 30, 40 lab notebooks. The SmithKline is directly on point. In the SmithKline case they compelled -- they found that 160 lab notebooks was not burdensome and then they compelled the production of lab notebooks relating to the drug Paroxetine. And Paroxetine is basically the accused product. It's a generic form of an antidepressant pill. And so the Court said produce the ones that relate to the accused product. And that's what we're asking. Produce the ones that relate to the development of the accused product. And that's what we're asking for.

THE COURT: All right. Anything further on behalf of Minerva?

MS. KIM: Yes, Your Honor. Two more points. The opposing counsel referred to

the dots in Ms. Hilario's lab notebook and I just want to point out that those dots were there in 2011 when the accused features were set.

Secondly, with regard to maybe the assumption that Mr. Truckai would not take his own notes and would have other technicians or engineers take notes for him, there's no evidence of that. And in fact, you know, if you look at other patents that Minerva has, if any technician or engineer were involved in developing that feature, they would be named as one of the inventors. Those other patents that opposing counsel is talking about definitely go to other features of the Minerva device, but not the accused feature. Again, Minerva has specifically identified in its interrogatory responses the independent development of the accused features and its own patents that go to those accused features. Thank you, Your Honor.

THE COURT: Thank you. Anything further on behalf of Hologic.

MR. CASAMIQUELA: Just one quick point on that last point. In the rog response

they don't -- they just list all their patents and patent applications. They list 49 patents and patent applications. They don't specify which of these patents or patent applications go to these accused features. They just list them all. And they say these go to the novel Minerva system. They don't specify these 10 patents go to the accused features and these -- you know, they list 25 patents that relate to the Minerva novel system and they list 24 patent applications that relate to the novel system.

THE COURT: All right. Having --

MS. KIM: Excuse me, Your Honor. May I?

THE COURT: Yes. One brief response. I'm prepared to make a ruling on the record for the parties today.

MS. KIM: Thank you. Just to make the record clear, we have cited and actually quoted some of our responses specifically identifying the accused features and which Minerva patents go to those accused features and the fact that these Minerva patents actually cite to the patents in suit and the family of

the patents in suit. So we made it very clear from early on as to which patents and which technologies independently developed by Minerva go to the accused features. Thank you.

THE COURT: Thank you. All right. Having read the submissions of the parties on the Plaintiff's application to compel production of lab notebooks and having heard the arguments today, I'm going to grant the request in part and deny it in part without prejudice.

As everyone knows, under the federal rules, specifically Rule 26, my obligation is to consider both relevance and proportionality. I am inclined on this record, with respect to the relevance portion of it, I don't believe that that is being disputed so much as to what is a proportional response to a request for the lab notebooks.

Minerva has asserted that there are at least 22 employees or former employees that have or have had one or more lab notebooks at Minerva and to compel production of all of those lab notebooks would be overly broad and unduly burdensome. For purposes of my ruling

and the record that I have before me today, I am accepting that, and therefore in granting Plaintiff's request, I am going to place some limitations on what Minerva needs to produce.

Minerva has offered to produce the lab notebooks of the custodians identified pursuant to the ESI order and three additional custodians, the Minerva engineers identified on page 4 of Minerva's submission, document item number 247, the engineers being Dominique Filloux, head of R&D, Estela Hilario, an engineer and Tejas Mazmudar, an engineer and Akas Toth, an engineer and inventor of Minerva's patents identified. So those are the custodians from whom I will order production of lab notebooks.

As to the time limitation, I will grant the time limitation requested by the Plaintiffs; that is, for those custodians, produce all lab notebooks dated prior to June 27, 2014. In reviewing the submissions there are two pages from lab notebooks of engineer Hilario that are dated June and July of 2013 respectively. The defense points out that those

just simply relate to quote, unquote, testing of the accused features that have already been established and set. Nonetheless, those features are, according to the Plaintiff, relating to the key allegations of infringement in the case. And so, I find that it is not disproportional to order production of all lab notebooks dated prior to June 27, 2014, from those custodians.

To the extent after this production is made and reviewed by Plaintiffs and perhaps there are further meet and confers if needed between counsel, at which time a resolution cannot be achieved with respect to any additional notebooks from the 22 employees or former employees of Minerva, then the Court will reconsider whether or not to extend the limitations imposed by this order.

Because I am ruling on the record, this transcript will serve as my order. Pursuant to Rule 72A of the federal rules of civil procedure, any party may serve and file objections to this transcript order within 14 days after being served with a copy and the

district judge will review it and decide any timely objections and will modify or set aside any part of my order that is clearly erroneous or contrary to law.

Are there any further matters on behalf of the Plaintiff that you wish to bring to the attention of the court at this time?

MR. CASAMIQUELA: No, Your Honor.

THE COURT: Are there any further matters on behalf of Defendant Minerva?

MS. KIM: No, thank you, Your Honor.

THE COURT: Thank you, counsel. Our teleconference is concluded.

(End at 12:50 p.m.)

State of Delaware)
)
New Castle County)

CERTIFICATE OF REPORTER

I, Stacy M. Ingram, Certified Court Reporter and Notary Public, do hereby certify that the foregoing record, Pages 1 to 23 inclusive, is a true and accurate transcript of my stenographic notes taken on June 21, 2017, in the above-captioned matter.

IN WITNESS WHEREOF, I have hereunto set my hand and seal this 21st day of June 2017, at Wilmington.

/s/ Stacy M. Ingram
Stacy M. Ingram, CCR

EXHIBIT L

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

HOLOGIC, INC. and CYTYC SURGICAL PRODUCTS, LLC, Plaintiffs and Counterdefendants, v. MINERVA SURGICAL, INC., Defendant and Counterclaimant.	C.A. No. 15-1031-JFB-SRF **JURY TRIAL DEMANDED**

DEFENDANT AND COUNTERCLAIMANT MINERVA SURGICAL, INC.'S
REBUTTAL FACT WITNESS LIST

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Dated: February 2, 2018

Pursuant to paragraph 2 of the Court's Amended Scheduling Order (D.I. 265), Defendant and Counterclaimant Minerva Surgical, Inc. ("Minerva") provides the following list of rebuttal fact witnesses that it intends to call at trial. Minerva reserves the right to supplement or modify this list if so warranted. Minerva also reserves the right to call any witness on the witness lists of Plaintiffs and Counterdefendants Hologic, Inc. and Cytyc Surgical Products, LLC.

- Avery Burns
- Dr. Peter Casella
- William Lucas Churchill
- Dave Clapper
- Eric Compton
- Dan Eby
- Dr. Edward Evantash
- Dominique Filloux
- Dr. Amy Garcia
- Dr. Douglas Gearity
- Daniel Hayes
- Dominic Hulton
- Mark Hunter
- Dr. William Jamieson
- Dr. Alan Johns
- Russell Layton
- Lance Lozan
- Paul MacNeill

- Burt Magen
- Adam Mascari
- Dr. Craig McKnight
- Michael Meier
- Dr. James Mirabile
- Jeffrey Mountain
- Nicholas Moussa
- Tom O'Neill
- Whitney Parachek
- Thomas Pendlebury
- Shacey Petrovic
- Colin Pollard
- Dr. David Schwartz
- Dr. Eugene Skalnyi
- Brian Smith
- Stephen Smith
- Akos Toth
- Dr. Robert Tucker
- Csaba Truckai

Respectfully submitted,

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Dated: February 2, 2018

CERTIFICATE OF SERVICE

I, Benjamin J. Schladweiler, hereby certify that on February 2, 2018, I caused the foregoing ***Defendant and Counterclaimant Minerva Surgical, Inc.'s Rebuttal Fact Witness List*** to be served via electronic mail upon the following counsel of record:

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/s/ Benjamin J. Schladweiler
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EXHIBIT M

EXHIBIT 19

EXHIBIT 19 TO PRETRIAL ORDER
GOOGLE'S LIST OF MISCELLANEOUS ISSUES

Google submits the following list of issues it believes should be addressed at the Pretrial Conference. Google reserves the right to modify or supplement this list at any time before the Conference.

1. By the very nature of this patent infringement suit, PUM has access to some of Google's most sensitive confidential information. Due to the strong protective order entered by this Court, Google has produced hundred of thousands of pages of materials that include highly sensitive engineering documents without troubling the Court with the concerns the company would otherwise have. While Google respects the right of public access to judicial proceedings, public dissemination of this information would cause considerable harm to Google's competitive standing; allowing companies to compete against Google without the years of refinement and significant financial outlay Google has invested in these trade secrets and other sensitive information. The strong public interest in protecting this kind of sensitive commercial information from disclosure outweighs the common law presumption of public access to judicial proceedings. Thus, testimony related to the confidential operations of Google's products and systems, particularly any source code, should be shielded from public disclosure. Accordingly, Google asks the Court to close the courtroom whenever testimony regarding Google's confidential commercial information is offered at trial, and to seal all documents and portions of transcripts discussing Google's sensitive commercial information. Google will work with PUM and the Court to limit any such closings and ensure the least disruption to the trial proceedings.

2. Google understands that in denying its motion to dismiss for lack of standing, the Court rejected Google's assertion that title never passed to PUM because PUM did not exist as a legal entity at the time Levino Ltd. assigned the patents-in-suit to PUM. (D.I. 396.) Accordingly, Google understands that this argument has been rejected as a matter of law and that the Court has found no related factual issues remain to be tried before the jury on this issue. However, if this incorrect , Google should be permitted to present evidence and argument on the issue of standing to the jury. Google requests clarification of the Court's finding on this issue.

3. Google's "Smart Ad Selection System" is sometimes referred to within the company by the acronym SmartASS. Google asked witnesses to refer to the system as SmartAds during depositions, but on occasion they or counsel used the term SmartASS. In addition, the term SmartASS appears in documents included on the parties' exhibit lists. Google requests that parties and witnesses refrain from using the term SmartASS in the presence of the jury. Google also requests that the term SmartASS be replaced with SmartAds in documents shown to the jury and in deposition designations played to the jury. PUM has indicated that it does not oppose Google's proposal herein.

4. Google believes that the meaning of the word "conceived" in Yochai Konig's employment agreement with SRI is an issue of law to be decided by the Court and that there is no conflicting extrinsic evidence such that this issue could be decided by the jury. However, Google understands that in denying Google's motion for summary judgment on its counterclaim of breach of contract and Google's motion for reconsideration, the Court rejected Google's position and will let the jury decide the meaning of the word

"conceived." (*See* D.I. 521; D.I. 537.) Google requests clarification if this understanding is incorrect.

Google responds below to the issues PUM has indicated should be addressed at the Pretrial Conference.

1. In its portions of the Pretrial Order (*see* Exhibit 18), PUM requests that Google and its experts be prohibited from rearguing claim construction positions. This, however, should apply to both parties. Both parties and their experts should be prohibited from rearguing claim construction positions rejected by the Court in its *Markman* opinion. The parties should apply the Court's claim constructions.

2. PUM includes in Exhibit 2 allegations regarding indirect infringement. As detailed in Google's Reply in Support of Google's Motion *in Limine* To Preclude Evidence or Arguments on Copying or Pre-Suit Knowledge, PUM did not disclose in discovery (including interrogatory responses and its infringement expert's report on infringement) that it contends Google indirectly infringes, or any facts to support such a claim. Thus, there are no legal and factual issues to be addressed at trial on indirect infringement to the jury on this issue and PUM, PUM should not be allowed to do so. As also explained in Google's Reply to MIL No. 1, PUM should not be allowed to use a claim of indirect infringement never disclosed in discovery as a way to introduce the pre-suit letters that are the subject of MIL No. 1.

3. PUM requests that Google be precluded from relying on PUM's infringement expert, Dr. Pazzani's articles as obviousness references. (*See* Exhibit 18.) Initially, this request is an improper motion *in limine* that should be disregarded by the Court.

In any event, as PUM admits, Google identified Dr. Pazzani's articles as prior art

in an interrogatory response served on June 9, 2011. And Google questioned Dr. Pazzani about those articles during his deposition. Thus, PUM has long been on notice that Google considered his articles to be prior art. That Google's invalidity expert did not rely on them does not mean they are inadmissible.

Indeed, PUM does not cite any case which indicates that Google can be precluded from providing evidence of the state of the art separate and apart from what an expert relies on. Nor could it. Obviousness is a question of law, and "precedent does not require 'expert' opinions on matters of law." *Soverain Software LLC v. Newegg Inc.*, 705 F.3d 1333, 1336, 1341 (Fed. Cir. 2013); *see also Friskit, Inc. v. RealNetworks, Inc.*, 499 F. Supp. 2d 1145 (N.D. Cal. 2007), *aff'd per curiam*, 306 Fed. Appx. 610 (Fed. Cir. 2009) (granting summary judgment of obviousness without relying on expert testimony). PUM also cannot demonstrate any prejudice here. The case cited by PUM, *Pfizer, Inc. v. Ranbaxy Labs., Ltd.*, 2005 WL 2296613 (D. Del. Sept. 20, 2005), does not support PUM's position. That case holds that an opposing party's expert's deposition testimony does not fall within the hearsay exception for statements by a person who has been authorized by a party to "make a statement concerning the subject," under F.R.E. 801(d)(2)(C). *Id.* Dr. Pazzani is listed as one of PUM's live witnesses, so Google should be able to introduce his two prior art articles through his live testimony.

4. PUM also asks that Google be precluded Matthew Montebello from testifying at trial. Again, this request is an improper motion *in limine* that should be disregarded by the Court.

Google disclosed Mr. Montebello in its Initial Disclosures on May 4, 2011, his article was disclosed as prior art in an interrogatory response served on May 12, 2011,

and Google's invalidity expert relied on his article as anticipatory prior art. And while PUM suggests that Google should have disclosed Mr. Montebello earlier as a "trial witness," Google disclosed him as a trial witness the day such disclosures were due, January 31, 2014. Here too, there is no prejudice. PUM made no effort to take any discovery as to any prior witness throughout the case, and never even asked Google which prior art witnesses it might rely on at trial during discovery.

Nevertheless, and notwithstanding the fact that it is well after the close of fact discovery, Google told PUM it would not object to Mr. Montebello (who resides in Malta and is not in Google's control) being deposed in the U.S. prior to trial. Google proposed that Mr. Montebello travel to the U.S. early for trial and be deposed prior to the start of trial when counsel will likely all be in Wilmington, which Mr. Montebello is willing to do. PUM has indicated it intends to proceed with this deposition.

5. PUM indicated in Exhibit 18 that it wishes to discuss the number of Google witnesses included on Google's witness list. As Google has explained to PUM and the Court (Dkt. No. 574), the number of potential live witnesses on Google's witness list is a direct result of PUM's own trial witness list and the unreasonable breadth of PUM's infringement case. PUM initially designated deposition testimony from 15 Google witnesses (current and former Google employees) and 24 witnesses total. It is unlikely that PUM intends to play all of the deposition testimony it designated. PUM takes issue with the fact that Google initially listed 13 of those Google witnesses as potential live witnesses. In other words, PUM apparently believes that it will need to rely on these witnesses' testimony to prove its infringement claims, but is seeking to preclude Google from having the ability to rely on those same witnesses' testimony to rebut PUM's claims. This is patently

unfair. In the course of preparing the Joint Pretrial Order, PUM has dropped two accused products, which resulted in PUM removing one Google witness from PUM's witness list. Google has removed the same witness, Andre Rohe, from its own witness list based on PUM's representation that it is dropping Google News from its list of accused products.

6. In Exhibit 18, PUM proposes that PUM be permitted to examine Google's live witnesses during Google's case and that PUM be permitted to exceed the scope of Google's direct examination. PUM further proposes that its case be left open pending completion of this testimony. Google does not agree to this proposal.

PUM has taken 19 depositions in this case. It has designated nearly 34 hours of deposition testimony. Rather than narrow its case, PUM suggests it wants to wait until Google puts on its case and try its case through the witnesses Google calls in its case. PUM is the plaintiff asserting that Google infringes its patents. The case that Google puts on to rebut PUM's case-in-chief on infringement, including which witnesses Google will call live, necessarily depends on the case-in-chief that PUM presents, including which witnesses or deposition testimony PUM presents, and which theories PUM presents. What PUM proposes will effectively allow PUM to further delay settling and narrowing PUM's actual infringement case. It would also unfairly force Google to put on a defense rebutting an infringement case that has not even been fully presented or that may change or evolve even after PUM's case in chief is done. PUM should to provide the evidence it believes it needs in its case-in-chief using the depositions it has taken of Google's witnesses.

Relatedly, PUM identifies Yochai Konig as a witness that it "may call" live. Rather than put on its affirmative case during PUM's case with Mr. Konig's testimony, Google intends to call Mr. Konig live during its case, but seeks guidance from the Court if its preference is for Mr. Konig to take the stand only once.

7. PUM requests that Google be precluded from referring to and presenting evidence of recent changes in its technology, including changes to the use of Google Search and [redacted] (*See* Exhibit 18.) This request is yet another improper motion *in limine* that should be disregarded by the Court. However, to the extent that the Court considers PUM's request, Google does not believe that it should be so precluded. Google could not disclose these changes during fact discovery because they had not yet occurred or been planned. For example, In August 2012, Google informed PUM that [redacted] that PUM accuses of infringing the patents-in-suit in connection with Google Search would be phased out. Google offered to provide PUM discovery on this change, but PUM chose not to pursue it. On January 16, 2014, Google produced documents from October 2013 – January 2014 concerning the planned elimination of the [redacted] functionality before trial.

There is no reason why Google should be precluded from informing the jury that Google does not use some of the accused functionality for some of the accused products anymore, or is planning to discontinue using those products, as PUM will presumably argue that its patents and their alleged use in Google's products are of great importance. Also, as purported evidence of secondary considerations of non-obviousness, PUM's invalidity expert points to purposed commercial success from Google's accused products. If PUM is permitted to introduce such evidence, and it should not as there is no nexus to

the accused functionality, Google should be permitted to refute it by showing that the accused functionalities did not even contribute to those revenues. Similarly, PUM's invalidity expert opined that Google's "continued adoption of the patented technology, for example, in [redacted]" is evidence of the patents' non-obviousness. Again, Google should be permitted to refute this argument by explaining that it is eliminating that functionality.

8. PUM notes in Exhibit 18 that Dr. Jordan served a supplemental report on February 14, 2014. This supplemental report is very limited; it only explains what has occurred in the *inter partes* reexaminations of the patents-in-suit since his last report was served. That is, the Examiner has issued Final Office Actions rejecting all asserted claims of both patents-in-suit, and PUM has appealed those decisions to the PTAB. To the extent that evidence or argument regarding the reexaminations is permitted (as it should be), Dr. Jordan should be able to provide the very minimal additional information referenced in his supplemental report so that the jury has current information.

9. In Exhibit 18, PUM suggests a hearing set following the conclusion of the jury trial at which argument can be presented. Google agrees with this approach, provided that such hearing be scheduled at a mutually convenient time for the parties and the Court.

10. In Exhibit 18, PUM indicates that it wishes to discuss Google's listing of Reuben Benquessos (Banks) and Levy Benaim, on its Fifth Supplemental Initial Disclosures. Google has never stated that it listed these witnesses "solely for purposes of harassment" as PUM states. Rather, Google has repeatedly explained to PUM that it is presently not planning to call either witness, but reserves its right to do so based on PUM's recent

representation of their importance to PUM and the potential that either is implicated in testimony and theories presented by PUM at trial. Both of these witnesses are individuals that PUM represented would be present for trial, and that the trial needed to be scheduled such that they could be available to attend.